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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,829	06/25/2003	Masato Oshina	W0200.0128/P128	9868

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EXAMINER


CHENEVERT, PAUL A

ART UNIT PAPER NUMBER

3612

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/602,829	Applicant(s) OSHINA ET AL. 	
	Examiner Paul A. Chenevert	Art Unit 3612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20040130</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country.
2. Acknowledgment is made of applicant's reference to a foreign application filed in Japan on 28JAN03. It is noted, however, that applicant has not claimed priority to this application or filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b).

Drawings

3. Figures 13-15 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: "45" in Figure 5.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. The incorporation of essential material in the specification (page 3, line 18) by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend

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the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

6. The disclosure is objected to because of the following informalities:
 - a. Page 4, line 15, "a" should be inserted before "bracket".
 - b. Page 6, lines 1 & 2, the repeated lines should be deleted.
 - c. Page 8, lines 16, 18, & 20, (prior art) should be inserted after the figure number.
 - d. Page 12, lines 7 & 10, "outer surface" should be changed to "leg members".
 - e. Page 12, line 24, "securing piece" should be changed to "connecting portion".
 - f. Page 14, line 16, "securing piece" should be changed to "connecting portion".
 - g. Page 14, line 17, "outer surface" should be changed to "leg members".
 - h. Page 15, line 3, "outer surface" should be changed to "leg members".

Appropriate correction is required.

Claim Objections

7. Claims 1-5 are objected to because of the following informalities: "a" should be inserted before "bracket" on claim 1, line 3. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

9. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 4 recites the limitation "securing structure" on line 3. There is insufficient antecedent basis for this limitation in the claim. It is unclear how this securing structure differs from the securing structure previously introduced in claim 2, line 3. It is thought that the securing structure of claim 2 refers to the 'sub-attaching groove' (55) shown in Figure 5 and the securing structure of claim 4 refers to the 'fixing groove' (56) also shown in Figure 5.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2, & 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Watanabe et al.

Watanabe et al. disclose a module structure comprising: attachment members (contractible member 16) formed on an accessory (assist grip 10); wherein said attachment

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member is connected into a bracket (energy absorbent member 38) provided on the back side of a roof trim (ceiling base member 30) and then inserted into attachment holes (36) in a roof panel (vehicle body 34); and wherein an inserted body (lock pin 20) is inserted into the attachment member.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 3 & 4 (as understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. in view of Nagamoto.

Watanabe et al. disclose a module structure as described above. The attachment members are secured to the bracket in a sub-attaching position by securing structure (large-width portion 26B presses the ceiling base member 30 towards small-width portion 28B). In regards to

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claim 4, the inserted body forces another securing structure (large-width portion 26A presses the vehicle body 34 towards small-width portion 28A) on the attachment members to fix the bracket, attachment members, and accessories in a secured position.

However, Watanabe et al. do not expressly disclose that the securing structure includes claws and grooves.

Nagamoto discloses a module structure comprising: attachment members (grommet 55); wherein said attachment member is connected into a bracket (recessed portion 46) and having claws (periphery of bottom hole 47) resting in grooves (first sector projection 74) and then inserted into attachment holes (through hole 97); and wherein an inserted body (press-fit pin 57) is inserted into the attachment member. In regards to claim 4, the inserted body forces another securing structure (second projection 75) on the attachment members to fix the bracket, attachment members, and accessories in a secured position.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the module structure of Watanabe et al., to employ claws engaging grooves, as taught by Nagamoto.

The suggestion/motivation for doing so would have been to more reliably secure the attachment member to the bracket, as is desired in this vehicle invention.

Therefore, it would have been a desirable and thus a prima facie obvious modification of the module structure by combining claws on the bracket with grooves on the attachment member to obtain the invention as specified in claim 3, as taught by the prior references' motivation, and not hindsight from the applicants disclosure.

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Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Chenevert whose telephone number is 703-305-0837. The examiner can normally be reached on Mon-Fri (8:30-5:00).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn D. Dayoan can be reached on 703-308-3102. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul A. Chenevert
Examiner
Art Unit 3612

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D. GLENN DAYOAN
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5/17/04